

REMARKS

Applicants appreciate the indication of allowable subject matter, i.e. that claims 39-41, 58-60 and 75-77 would be allowable if written in independent form.

Claims 33-77 have been cancelled without prejudice, and claims 78-116 have been added. No new matter has been added by virtue of the amendments. For instance, support for the new claims appears e.g. at page 5, line 25 through page 6, line 2 and the original claims of the application.

Claims 33-37, 44-46, 48-56, 63-65 and 67-73 were rejected under 35 U.S.C. 102 over Hayase et al. (U.S. Patent 5403695). The rejection is traversed.

The pending claims recite features that were free of rejection over Hayase et al. In particular, independent claims 78 and 109 recite features of previous claim 38, which was not rejected over Hayase et al. Independent claims 87 and 98 recite features that were indicated to be allowable.

In view thereof, withdrawal of the rejection is requested.

Claims 33-37, 42-45, 47, 48-56, 61-64 and 66-73 were rejected under 35 U.S.C.103 over Sato et al. (U.S. Patent 5,955,240).

As in the prior rejection, the pending claims recite features that were free of rejection over Sato et al. Thus, independent claims 78 and 109 recite features of previous claim 38, which was not rejected over Sato et al. Independent claims 87 and 98 recite features that were indicated to be allowable. Withdrawal of the rejection is requested.

Claims 38, 57 and 74 were rejected under 35 U.S.C. 103 over Sato et al. (U.S. Patent 5,955,240) in view of Oomori et al. (U.S. Patent 6,387,587). In the Office Action (page 4), it is acknowledged that "Sato does not teach the resin has phenolic group and alkyl acrylate groups" Nevertheless, the position is taken in the Office Action that:

"It would have been obvious to one of ordinary skill in the art to use the resin taught in Oomori having phenolic and alkyl acrylate groups in the photoresist composition of Sato wherein the resin has phenolic groups"

The rejection is traversed.

All the pending claims call for a photoresist that comprises either lactic acid or acetic acid.

Oomori does not disclose either of those acids. Rather, Oomori reports certain cyclic and aromatic acids. See Oomori at column 6, lines 5-16.

Also, contrary to the position advanced in the Office Action, photoresist workers would not have considered that the Sato poly(phenolic) resin or composition components thereof would be readily interchangeable with the type of composition reported in Oomori. Notable differences exist between the systems of Sato et al. and Oomori et al. For instance, Sato reports a blend of polyhydroxystyrene resins where one of the resins is substituted with groups of the described formula I. Those groups of formula I would not be present on the cited phenolic/acrylate polymer of Oomori. Accordingly, the skilled worker would not particularly expect that a component of Sato might be suitable or provide desired results with the Oomori et al. composition that contains a distinct resin.

Additionally, the application as filed includes comparative results that show use of a photoresist with an acid as claimed provided enhanced performance, particularly enhanced storage stability. See the results of Examples 1-4 (pages 16-20 of the application), and wherein comparative Example 4 inferior storage stability was exhibited.

Moreover, neither Sato et al. nor Oomori et al. disclose or otherwise suggest a photoresist composition that contains lactic acid. Claims 95, 109-112 and 116 call for the presence of lactic acid. The above noted comparative examples set forth in the application as filed disclose results with photoresists containing lactic acid.

In view thereof, reconsideration and withdrawal of the rejection are requested.

It is believed the present application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,



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